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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

60109

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on October 12, 2005

Signature

Typed or printed name William Y. Conwell

Application Number

09/502,542

Filed

2/10/00

First Named Inventor

Bruce L. Davis

Art Unit

3625

Examiner

M. Fadok

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒ attorney or agent of record.  
Registration number 31,943

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

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Telephone number

October 12, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☐ \*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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## REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

All of the claims stand rejected over Swartz (6,243,447) – either solely, or in combination with other art.

Swartz discloses a self-checkout system for a retail store, in which a shopper equipped with a personal barcode scanner scans items put into their grocery cart, thereby generating a list. At the checkout register, a cashier retrieves the scanned list and charges the shopper accordingly.<sup>1</sup>

Swartz's scanner can also be used to compile a predicted shopping list (based on a shopper's historical shopping practices), which can be retrieved by the shopper for later use at the store.<sup>2</sup>

The § 102 rejection of claim 1 will fail, *e.g.*, because contrary to the Final Action, Swartz does not teach the last two claim clauses.

In this claim, as in others, applicants have emphasized the interrelationship between activities in (1) a bricks and mortar store, and (2) an online shopping environment. Swartz concerns just a bricks and mortar store. He has no teaching concerning online shopping environments.

Contrary to the Action, col. 8, lines 7-53 of Swartz does not teach “*using said recalled list to present a customized selection of items in an on-line shopping environment.*” Rather, this passage teaches compiling a list of items while shopping in a retail store.

Likewise, contrary to the Action, col. 3, lines 18-39 does not teach “*receiving input from a user identifying a subset of items from said customized selection of items [presented in the on-line shopping environment].*” Rather, this passage again teaches creation of a list while shopping in a retail store (and the use of such a list as a “predicted shopping list” during subsequent shopping).

The § 102 rejection of claim 20 will fail similarly. Swartz does not teach “*using the data thereby acquired [during a shopper's visit to a bricks and mortar store] in a later on-line shopping session with said shopper.*” (The Action does not particularly provide a citation in connection with this clause from claim 20, instead saying “see response to claim 1.” Again, the passages from Swartz cited in connection with claim 1 do not teach the claim limitations for which they were offered.)

The § 103 rejection of independent claim 3 (over Swartz and alleged Official Notice<sup>3</sup>) will fail because Swartz again fails to teach that for which it is cited.

For example, claim 3 is drawn to “a method of conducting an *online* shopping session.” Contrary to the Final Action, Swartz does not concern an online shopping session. Rather, his disclosure concerns retail shopping environments, with physical aisles and physical checkout registers, etc. This is the opposite of the online shopping

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<sup>1</sup> Swartz, US 6,243,447, col. 3, lines 43-64.

<sup>2</sup> Swartz, US 6,243,447, col. 3, lines 35-39.

<sup>3</sup> In a Response After Final, applicants have invited the Office to reconsider reliance on Official Notice in this and certain other rejections, because such reliance is contrary to the guidance offered by the MPEP.

arrangement required by the claim language. (Note that the “online” limitation is found not just in the claim preamble, but also in the body of the claim – in the last clause.)

Moreover, claim 3 requires, “*querying the user regarding possible purchase of an item not selected by the user but on said recalled list, before completing the online shopping session.*” The Final Action acknowledges that Swartz has no disclosure on this point.

The Final Action improperly dismisses this claim limitation by reference to Official Notice.

In its section § 2144.03 on Official Notice, the MPEP counsels:

*Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While "official notice" may be relied on, these circumstances should be rare when an application is under final rejection.*<sup>4</sup>

In addition to discouraging reliance on Official Notice in final rejection, the MPEP also counsels that such Notice should be used only in circumstances where it serves to “fill in the gaps in an insubstantial manner.”<sup>5</sup>

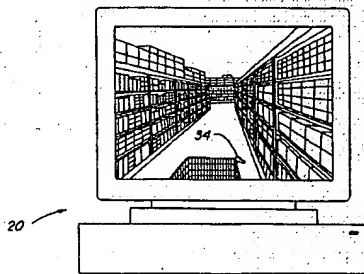
In the present case, in contrast, Official Notice has been taken of a substantive claim limitation – one that goes far beyond the permitted “gap filling” case.

The rejection of claim 3 will be recognized by the Board as one in which the Office has impermissibly used applicants’ disclosure as a hindsight guide, and relied on Official Notice sleight-of-hand when documentary art failed to support the rejection. Again, such rejection will fail.

The § 102 rejection of independent claim 7 will fail, *e.g.*, because Swartz again fails to teach that for which it has been cited. The claim requires “*logging a shopper's habits or preferences exhibited in an on-line shopping environment...*” (The claim concludes by requiring use of the logged information in connection with bricks and mortar shopping by the user.)

Again, the Action has ignored the “on-line shopping environment” requirement of the claim. Swartz, in contrast, teaches only shopping in a conventional retail (*i.e.*, bricks and mortar) environment.

Independent claim 9 stands rejected over Kenney in view of Swartz. Kenney teaches a virtual shopping arrangement having a visual look like that of a physical store:



<sup>4</sup> Emphasis added.

<sup>5</sup> MPEP § 2144.03.

Among other failings, the rejection of claim 9 will be reversed because Swartz again does not teach that for which it has been cited. The Final Action states, “*Swartz teaches scanning data on a device, which can later be used to purchase products on-line (see response to claim 1).*”

Not so. As noted, Swartz does not teach purchasing products on-line.

Because the art does not teach that for which it has been cited, the Action falls short of the *prima facie* burden required to establish obviousness of claim 9.

Independent claims 17 and 19 also stand rejected over Kenney in view of Swartz, and are likewise premised on the erroneous belief that Swartz teaches purchasing products on-line. Again, this error will lead to reversal of the claim 17 and 19 rejections.

Moreover, claim 17 will be recognized as including all of the language of claim 9, to which is added the concluding limitation, “*wherein said items of potential interest include at least one item that the shopper has not previously purchased from said first vendor.*” The Final Action dismisses this by reference to the “Special Today” indicia shown in Kenney’s Fig. 7.

However, Kenney does not teach that the product marked “Special Today” in his Fig. 7 is an item “that the shopper has not previously purchased from said first vendor,” as required by claim 17. Again, this failure of the art to teach that for which it cited will lead the Board to reverse the rejection.

In addition to the above-noted error in the Office’s rejection of claim 19, the claim also requires displaying a virtual shopping aisle in which items of potential interest – identified by sensing data from products while at the shopper’s residence – are presented more prominently than other items.

While Swartz suggests that products may be identified with his scanner at the shopper’s residence, the Action resorts to impermissible hindsight to suggest that products identified in this way be presented more prominently than other items. Neither Swartz nor Kenney has a suggestion leading to such an arrangement. Again, the rejection falls short.

Independent claim 18 stands rejected over Kenney in view of Swartz and Official Notice. Claim 18 is patterned after claim 9, and the Office’s rejection of claim 18 is similarly patterned after its rejection of claim 9 – including the erroneous assertion that Swartz teaches a method of on-line shopping. Again, this error in application of Swartz will lead to reversal of the rejection.

Moreover, claim 18 is directed to a method of on-line shopping from a first vendor, which relies on transactions with vendors *other than said first vendor*.

The Final Action acknowledges that both Kenney and Swartz are silent on this feature. However, resort is again made to Official Notice.

As discussed above in connection with claim 3, such reliance on Official Notice will not withstand the Board’s scrutiny. In addition to being discouraged in a Final Action, Official Notice is again being cited against a substantive claim limitation – rather than serving to “fill in the gaps in an insubstantial manner,” as counseled by the MPEP.

Moreover, the rejection of claim 18 again evidences impermissible hindsight – citing art until it runs short, and then resorting to the expediency of applicants’ own

specification – reinterpreted as “well-known prior art” by the Office. Again, this falls short of the burden imposed by § 103.

For brevity’s sake, the foregoing discussion has reviewed just the eight independent claims pending in the application, and only selected points have been reviewed in connection with each. Many other points that might have been raised concerning the claims, the art, and the rejections, have not been belabored.

Nonetheless, the foregoing brief observations are believed sufficient to establish that the outstanding rejections would not be sustained by the Board.